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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,783	07/10/2003	Klaus Hohn	12406-006003	2003
26161	7590	07/27/2004	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			TRAN, MINH LOAN	
			ART UNIT	PAPER NUMBER
			2826	

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/616,783	HOHN ET AL.
	Examiner	Art Unit
	Minh-Loan T. Tran	2826

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 10 July 2003.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 17-36 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 17-36 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 10 July 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## DETAILED ACTION

1. The Preliminary Amendment filed on 7/10/2003 has been entered.

### *Priority*

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. PCT/DE97/02139, filed on 09/22/1997.

### *Information Disclosure Statement*

3. If applicant is aware of any relevant prior art, he/she requested to cite it on form PTO-1449 in accordance with the guidelines set forth in M.P.E.P. 609.

### *Oath/Declaration*

4. The oath or declaration filed on 07/10/2003 is acceptable.

### *Drawings*

5. The drawings filed on 7/10/2003 are acceptable.

### *Claim Objections*

6. Claims 17, 20, 28, 31 are objected to because of the following informalities:

In claim 17, line 10, " d50" should be changed to – mean grain diameter  $d_{50}$ — for clarity.

In claims 20 and 31, line 1, " d50" should be changed to – mean grain diameter  $d_{50}$ —for clarity.

In claim 28, line 8, “ d<sub>50</sub>” should be changed to – mean grain diameter d<sub>50</sub>— for clarity.

In claim 17, lines 7 and 8; “ rear” should be changed to – rare—for clarity.

Appropriate correction is required.

*Claim Rejections - 35 USC § 112*

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 23 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 23 and 32, line 1, “ the iron content” lacks of antecedent basis.

*Double Patenting*

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 17-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,066,861; over claims 1-16 of U.S. Patent No. 6,245,259; over claims 1-10 of U.S. patent No. 6,592,780 and over claims 1-21 of U.S. Patent No. 6,613,247. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of present application and the patents recite a wavelength-converting casting composition containing a transparent epoxy resin and luminous substance particles; wherein the luminous substance particles comprising luminous substance pigments selected from the group consisting of garnets doped with rare earths; thiogallates doped with rare earths; aluminates doped with rare earths; and

orthohsilicates doped with rare earths; and the luminous substance pigments having grain size  $\leq 20 \mu\text{m}$  and mean grain diameter  $\leq 5 \mu\text{m}$ . However, the claims of present application do not recite the wavelength-converting casting composition for converting a wavelength of ultraviolet, blue or green light emitted by an electroluminescent component. It would have been obvious to one of ordinary skill in the art to form the device of present application having a wavelength-converting casting composition for converting a wavelength of ultraviolet, blue or green light emitted by an electroluminescent component, because such structure is conventional in the art for forming the white light electroluminescent diode.

Claims 17-36 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 10/429,916 and over claims 1-23 of copending Application No. 10/623,819. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of present application and the copending Applications recite a wavelength-converting casting composition containing a transparent epoxy resin and luminous substance particles; wherein the luminous substance particles comprising luminous substance pigments selected from the group consisting of garnets doped with rare earths; thiogallates doped with rare earths; aluminates doped with rare earths; and orthohsilicates doped with rare earths; and the

luminous substance pigments having grain size  $\leq 20 \mu\text{m}$  and mean grain diameter  $\leq 5 \mu\text{m}$ . However, the claims of present application do not recite the wavelength-converting casting composition for converting a wavelength of ultraviolet, blue or green light emitted by an electroluminescent component. It would have been obvious to one of ordinary skill in the art to form the device of present application having a wavelength-converting casting composition for converting a wavelength of ultraviolet, blue or green light emitted by an electroluminescent component, because such structure is conventional in the art for forming the white light electroluminescent diode.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

*Conclusion*

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh-Loan T. Tran whose telephone number is (571) 272-1922. The examiner can normally be reached on Monday-Friday 9:00 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mlt



Minh-Loan T. Tran

Primary Examiner

Art Unit 2826